

ESTTA Tracking number: **ESTTA676364**

Filing date: **06/04/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91220652
Party	Defendant Sisters of Charity of Leavenworth Health System, Inc.
Correspondence Address	JAMES R HASTINGS COLLEN IP THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562 UNITED STATES jhastings@collenip.com, gdavis@collenip.com, docket@collenip.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Govinda M. Davis
Filer's e-mail	gdavis@collenip.com, jhastings@collenip.com, docket@collenip.com
Signature	/Govinda M. Davis/
Date	06/04/2015
Attachments	R347 Amended Answer and Counterclaims.pdf(1204088 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----	X	
)	
BLUE CROSS AND)	
BLUE SHIELD ASSOCIATION)	
)	
Opposer/Counterclaim)	
Respondent,)	
)	
v.)	Opposition No. 91220652
)	
SISTERS OF CHARITY OF)	Serial No. 86/233,170
LEAVENWORTH HEALTH)	
SYSTEM, INC.,)	
)	
Applicant/Counterclaim)	
Petitioner)	
-----	X	

**AMENDED ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM
TO NOTICE OF OPPOSITION**

The Applicant, Sisters of Charity of Leavenworth Health System, Inc. (hereinafter "Applicant"), answers the Notice of Opposition as follows:

1. Applicant denies the allegations of paragraph 1 of the Notice of Opposition, but admits that it caused to be filed with the United States Patent and Trademark Office Application No. 86/223,170 for "hospital administration services; Hospital management," in International Class 035 and "Health care; hospitals," in International Class 044.

2. Applicant lacks information or belief with regard to the allegation of paragraph 2 of the Notice of Opposition, and therefore, denies the allegation of paragraph 2.

3. Applicant lacks information or belief with regard to the allegation of paragraph 3 of

the Notice of Opposition, and therefore, denies the allegation of paragraph 3.

4. Applicant lacks information or belief with regard to the allegation of paragraph 4 of the Notice of Opposition, and therefore, denies the allegation of paragraph 4.

5. Applicant lacks information or belief with regard to the allegation of paragraph 5 of the Notice of Opposition, and therefore, denies the allegation of paragraph 5.

6. Applicant lacks information or belief with regard to the allegation of paragraph 6 of the Notice of Opposition, and therefore, denies the allegation of paragraph 6.

7. Applicant lacks information or belief with regard to the allegation of paragraph 7 of the Notice of Opposition, and therefore, denies the allegation of paragraph 7.

8. Applicant lacks information or belief with regard to the allegation of paragraph 8 of the Notice of Opposition, and therefore, denies the allegation of paragraph 8.

9. Applicant denies the allegations of paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations of paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations of paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations of paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations of paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations of paragraph 14 of the Notice of Opposition.

APPLICANT'S AFFIRMATIVE DEFENSES

1. Opposer should be denied relief under the equitable doctrine of unclean hands because Opposer has improperly maintained one or more registrations that it asserts as the

basis of this Opposition without having *bona fide use in the ordinary course of trade* and continuous commercial use in commerce in connection with some or all of the goods and services that are subject of the registrations pleaded in this Opposition.

2. Some or all of Opposer's pleaded marks are not famous pursuant to 15 U.S.C. § 1125(c).
3. There is no likelihood that consumers will confuse Applicant's Mark with Opposer's pleaded marks.

COUNTERCLAIM

1. The Counterclaim Petitioner, Sisters of Charity of Leavenworth Health System, Inc. (hereinafter "Petitioner"), is a faith-based, nonprofit healthcare organization that operates eight hospitals, four safety net clinics, one children's mental health center and more than 190 ambulatory service centers in three states – Colorado, Kansas and Montana.
2. Upon information and belief, Counterclaim Respondent, Blue Cross and Blue Shield Association (hereinafter "Respondent"), is a national federation of 37 independent, community-based and locally operated companies.
3. Since as early as 1976, Petitioner has continuously used in commerce, a Greek Cross and heart design in association with its hospital and health care services.
4. Petitioner is the owner of U.S. Registration No. 1,766,130 of a Greek Cross and heart design for "hospital management services; medical referral services" in International Class 035; and "health care and hospital services; medical assistance, counseling, medical

information services; medical laboratory services; home health care, nursing, outpatient and medical clinic services; hospice services; mental health services” in International Class 042 with a first use date of December 1976, a registration date of April 20, 1993 and renewed as of April 9, 2013. A copy of Petitioner’s Registration No. 1,766,130 and the corresponding TESS printout showing status of the mark are annexed hereto and incorporated herein as “Exhibit A.”

5. Petitioner’s Registration No. 1,766,130 is an active registration in full force and effect on the Principal Register of the United States Patent and Trademark Office records.

6. Upon information and belief, Respondent, Blue Cross and Blue Shield Association, has never challenged Petitioner’s right to use and/or register Petitioner’s Greek Cross and heart design in connection with any or all of the services set forth in Petitioner’s U.S. Registration No. 1,766,130 (hereinafter “Respondent”).

7. Petitioner’s Application No. 86/233,170 is an updated version of Petitioner’s Greek Cross and heart design mark depicted in Petitioner’s U.S. Registration No. 1,766,130 that has been now in use for almost forty (40) years without challenge by Respondent.

Petition to Cancel Registration No. 0554817 for Greek Cross Design

8. Petitioner repeats and re-avers the allegations contained in paragraphs 1 through 7 of its Counterclaim as if fully set forth herein.

9. As grounds for notices of opposition that it has filed over the past several years, Respondent asserted, *inter alia*, U.S. Registration No. 0554817 depicting a design mark of a

Greek Cross (hereinafter the “‘817 Registration”). A copy of the registration certificate, the corresponding TESS printout showing status of the mark, and specimen are annexed hereto and incorporated herein as “Exhibit B.”

10. Respondent relies on, *inter alia*, its alleged rights in the ‘817 Registration as grounds for this Opposition proceeding.

11. The services that are the subject of the ‘817 Registration are “distribution of hospital care on a pre-payment financing basis” in International Class 036.

12. On or about December 7, 2011, Respondent caused to be filed with the United States Patent and Trademark Office a document entitled, *Combined Declaration of Use and/or Excusable Non-Use and Application for Renewal of Registration of a Mark Under Sections 8 and 9*, as it relates to the ‘817 Registration (hereinafter the “Section 8 and 9 Declaration”).

13. In support of its Section 8 and 9 Declaration filed with the United States Patent and Trademark Office, Respondent submitted specimens of use allegedly evidencing use of the ‘817 Registration in commerce in connection with all of the goods listed in the subject registration, “consisting of a(n) marketing materials on licensee’s website.”

14. The specimen submitted in connection with Respondent’s Section 8 and 9 Declaration filed in connection with the ‘817 Registration does not depict Respondent’s Greek Cross design mark anywhere on the specimen as used in association with the registered services.

15. At the time it submitted its Section 8 and 9 Declaration on or about December 7, 2011, Respondent had full knowledge that the Greek Cross design mark that is the subject of

the '817 Registration was not being used in a *bona fide manner in the ordinary course of trade*, in commerce on or in connection with the specimens.

16. Upon information and belief, and based on a review of publicly available sources, Respondent had discontinued its use of the Greek Cross design mark that is the subject of the '817 Registration and did not have an intent to resume use of the mark prior to the time that it filed its Section 8 and 9 Declarations on or about December 7, 2011.

17. Alternatively, upon information and belief, and based on a review of publicly available sources, Respondent had not been using the Greek Cross design mark that is the subject of the '817 Registration for a period of at least three consecutive years prior to the time it filed its Section 8 and 9 Declarations on or about December 7, 2011.

18. Upon information and belief, Respondent has abandoned its rights in and to the '817 Registration.

19. Petitioner has been, and is continued to be damaged, by maintenance of the '817 Registration.


PRAYER FOR RELIEF

WHEREFORE, Applicant/Counterclaim Petitioner prays that:

1. Opposition No. 91220652 be dismissed in all respects;
2. Applicant's Serial No. 86/233,170 proceed to registration;

3. Counterclaim Respondent's Registration No. 0554817 of a Greek Cross Design be cancelled; and any and all other legal or equitable relief that the Board deems just and proper.

Respectfully submitted,

By: 
James R. Hastings
Govinda M. Davis
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Avenue
Ossining, New York 10562
Tel.: (914) 941-5668
Fax: (914) 941-6091
jhastings@collenip.com
gdavis@collenip.com

Dated: June 4, 2015

Enclosures: Exhibits A-B

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE TRADEMARK TRIAL AND APPEAL BOARD OF THE UNITED STATES PATENT AND TRADEMARK OFFICE BY THE ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS (ESTTA).

By: 

Date: June 4, 2015

CERTIFICATE OF SERVICE

I, Meaghan C. Machcinski, do hereby certify that on June 4, 2015, a true copy of Applicant's Amended Answer to Notice of Opposition and Counterclaims was duly served upon the Opposer's counsel of record by placing a true copy in the United States Mail with sufficient postage thereon to carry same to its destination via First Class Mail, and addressed to:

Hanson Bridgett LLP
425 Market Street, 26th Floor
San Francisco, CA 94105
Attention: Mr. Garner K. Weng, Esq.



Meaghan C. Machcinski

EXHIBIT A

Blue Cross & Blue Shield Association v Sisters of Charity

Opposition No. 91220652

Exhibit to Sisters of Charity of Leavenworth Health System, Inc.'s Amended Answer and Counterclaims

Int. Cls.: 35 and 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 1,766,130

Registered Apr. 20, 1993

**SERVICE MARK
PRINCIPAL REGISTER**



**SISTERS OF CHARITY OF LEAVENWORTH
HEALTH SERVICES CORPORATION
(KANSAS CORPORATION)
4200 SOUTH 4TH STREET TRAFFICWAY
CANTWELL HALL
LEAVENWORTH, KS 66048**

**FOR: HOSPITAL MANAGEMENT SERVICES;
MEDICAL REFERRAL SERVICES, IN CLASS
35 (U.S. CL. 101).**

**FIRST USE 12-0-1976; IN COMMERCE
2-10-1977.**

**FOR: HEALTH CARE AND HOSPITAL
SERVICES; MEDICAL ASSISTANCE, COUN-
SELLING, MEDICAL INFORMATION SERV-**

**ICES; MEDICAL LABORATORY SERVICES;
HOME HEALTH CARE, NURSING, OUTPA-
TIENT AND MEDICAL CLINIC SERVICES;
HOSPICE SERVICES; MENTAL HEALTH
SERVICES, IN CLASS 42 (U.S. CL. 100).**

**FIRST USE 12-0-1976; IN COMMERCE
2-10-1977.**

**THE MARK CONSISTS OF A ROMAN CROSS
AND A HEART SUPERIMPOSED UPON A
GREEK CROSS.**

SER. NO. 74-162,445, FILED 4-30-1991.

RANDY RICARDO, EXAMINING ATTORNEY



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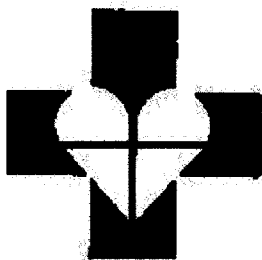
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Goods and Services IC 035. US 101. G & S: hospital management services; medical referral services. FIRST USE: 19761200. FIRST USE IN COMMERCE: 19770210

IC 042. US 100. G & S: health care and hospital services; medical assistance, counselling, medical information services; medical laboratory services; home health care, nursing, outpatient and medical clinic services; hospice services; mental health services. FIRST USE: 19761200. FIRST USE IN COMMERCE: 19770210

Mark Drawing Code (2) DESIGN ONLY

Design Search Code 02.11.01 - Hearts excluding hearts as carriers or depicted on playing cards
24.13.02 - Cross, Greek (equal sides); Greek cross (equal sized lines)

Serial Number 74162445

Filing Date April 30, 1991

Current Basis 1A

Original Filing Basis 1A

Published for Opposition December 17, 1991

Registration Number 1766130

Registration Date April 20, 1993

Owner (REGISTRANT) SISTERS OF CHARITY OF LEAVENWORTH HEALTH SERVICES CORPORATION

CORPORATION KANSAS 2420 West 26th Avenue, Suite 300-D Denver COLORADO 80211

**Assignment
Recorded** ASSIGNMENT RECORDED**Attorney of
Record** Carl Baranowski**Description
of Mark** The mark consists of a Roman cross and a heart superimposed upon a Greek cross.**Type of
Mark** SERVICE MARK**Register** PRINCIPAL**Affidavit
Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130409.**Renewal** 2ND RENEWAL 20130409**Live/Dead
Indicator** LIVE[TESS HOME](#)[NEW USER](#)[STRUCTURED](#)[FREE FORM](#)[BROWSE DICS](#)[SEARCH OG](#)[TOP](#)[HELP](#)[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

EXHIBIT B

Blue Cross & Blue Shield Association v Sisters of Charity

Opposition No. 91220652

Exhibit to Sisters of Charity of Leavenworth Health System, Inc.'s Amended Answer and Counterclaims

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

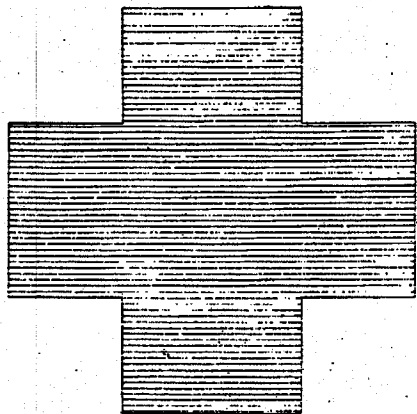
10 Year Renewal

Reg. No. 554,817

Registered Feb. 12, 1952

Renewal Term Begins Feb. 12, 1992

**SERVICE MARK
PRINCIPAL REGISTER**



BLUE CROSS AND BLUE SHIELD AS-
SOCIATION (ILLINOIS CORPORA-
TION)

676 N. ST. CLAIR ST.

CHICAGO, IL 60611, BY ASSIGNMENT
AND MERGER WITH AMERICAN
HOSPITAL ASSOCIATION (ILLINOIS
CORPORATION) CHICAGO, IL

THE DRAWING IS LINED TO INDI-
CATE THE COLOR BLUE.

FOR: DISTRIBUTION OF HOSPITAL
CARE ON A PRE-PAYMENT FINANC-
ING BASIS, IN CLASS 102 (INT. CL. 36).
FIRST USE 12-0-1934; IN COMMERCE
12-0-1934.

SER. NO. 71-531,753, FILED 8-19-1947.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Apr. 28, 1992.*

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Goods and Services IC 036. US 102. G & S: DISTRIBUTION OF HOSPITAL CARE ON A PRE-PAYMENT FINANCING BASIS. FIRST USE: 19341200. FIRST USE IN COMMERCE: 19341200

Mark

Drawing Code (2) DESIGN ONLY

Design 24.13.02 - Cross, Greek (equal sides); Greek cross (equal sized lines)

Search Code 26.17.01 - Bands, straight; Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s)

26.17.04 - Bands, vertical; Bars, vertical; Lines, vertical; Vertical line(s), band(s) or bar(s)

26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal

Serial Number 71531753

Filing Date August 19, 1947

Current Basis 1A

Original Filing Basis 1A

Registration Number 0554817

Registration Date February 12, 1952

Owner (REGISTRANT) AMERICAN HOSPITAL ASSOCIATION CORPORATION ILLINOIS 18 EAST DIVISION STREET CHICAGO ILLINOIS

(LAST LISTED OWNER) BLUE CROSS AND BLUE SHIELD ASSOCIATION CORPORATION BY MERGER WITH ILLINOIS 676 N. ST. CLAIR ST. CHICAGO ILLINOIS 60611

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Melissa Rotunno
Description of Mark THE DRAWING IS LINED TO INDICATE THE COLOR BLUE.
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECTION 8(10-YR) 20120113.
Renewal 4TH RENEWAL 20120113
Live/Dead Indicator LIVE

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We have a wide range of plans to meet your needs.

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Plans starting at
\$76
per month*

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Medicare and Retirement

Our [Medicare Supplement](#) and [Medicare Part D](#) plans can help cover medical and prescription expenses that Medicare doesn't.

*for a 30-year-old male non-smoker living in ZIP code 60045.

Looking for coverage?

- Get started with the basics
- Browse individual and family plans
- Get a quick quote

Eligible or preparing for Medicare?

New to Blue Cross and Blue Shield of Illinois?

Shopping for Insurance?



Quick Quote
(Under 65)



Shop by Price
(Under 65)

65+

Medicare
Supplement Quote

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Part D Pricing

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Coverage Options - Blue Cross and Blue Shield of Illinois



Individual and Family Plans

If you do not have health care coverage through an employer because you work part-time, are unemployed or self-employed, you can buy your own insurance. This is called individual health insurance, which can be purchased for yourself or your entire family.

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Medicare and Retirement

Medicare is health insurance for people age 65 or older or people under age 65 with certain disabilities or illnesses. However, Medicare doesn't cover everything. Medicare Supplement Insurance and Medicare Part D plans can help cover medical and prescription expenses that Medicare does not.

- [View Medicare Supplement plans](#)
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Employer-Offered Plans

Many people get health insurance through their employer. This is called employer offered or group coverage. Employers usually offer a choice of insurance plans. [Learn more about the types of group coverage](#) offered by Blue Cross and Blue Shield of Illinois and the advantages of becoming a member.

Looking for coverage for your employees?

If you are a small business owner or benefits administrator searching for group insurance for your employees, [view our group options and other resources for employers](#).

http://www.bcbsil.com/medicare/part_d_plans.html

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Coverage Options

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Individual and Family Plans

If you do not have health care coverage through an employer because you work part-time, are unemployed or self-employed, you can buy your own insurance. This is called individual health insurance, which can be purchased for yourself or your entire family.

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Get a Quote

Get a quote for individual and family plans.

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Medicare and Retirement

Medicare is health insurance for people age 65 or older or people under age 65 with certain disabilities or illnesses. However, Medicare doesn't cover everything. Medicare Supplement Insurance and Medicare Part D plans can help cover medical and prescription expenses that Medicare does not.

- [View Medicare Supplement plans](#)
- [Learn more about our 2012 Medicare Part D \(prescription\) plans](#)
- [Learn more about our 2011 Medicare Part D \(prescription\) plans](#)



Employer-Offered Plans

Many people get health insurance through their employer. This is called employer offered or group coverage. Employers usually offer a choice of insurance plans. [Learn more about the types of group coverage](#) offered by Blue Cross and Blue Shield of Illinois and the advantages of becoming a member.

Looking for coverage for your employees?

If you are a small business owner or benefits administrator searching for group insurance for your employees, [view our group options and other resources for employers](#).